

Appln. No. 09/785,700
Amendment dated November 6, 2006
Reply to Office Action of September 6, 2006
Docket No. 6169-156

IBM Docket No. BOC9-2000-0017

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REMARKS/ARGUMENTS

These remarks are made in response to the Final Office Action of September 6, 2006 (hereinafter Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. Nonetheless, the Examiner is expressly authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 50-0951.

Claims 1, 3-6, 7-13, 16, and 18-24 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2001/0039514 to Barenbaum (hereinafter Barenbaum). Claims 2 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Barenbaum, in view of U.S. Patent No. 6,611,811 to Deaton (hereinafter Deaton).

Applicants' Invention Predates Barenbaum

Applicants respectfully disagree that all of the features recited in the claims are disclosed by Barenbaum, either alone or in combination with Deaton. Applicants respectfully submit, however, that the issue is moot because Applicants' invention predates the April 4, 2000, filing of the provisional application to which Barenbaum claims priority.

In support of their contention, Applicants submit herewith their respective Declarations. The Declarations establish conception and continuing diligence from a time prior to the effective date of Barenbaum to the filing of the Application.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2001-0027, titled *Method and Apparatus to Stimulate Shopping* (hereinafter Disclosure). Additionally, Applicants submit herewith a copy of an entry, dated February 8, 2000, from the notebook of one of the Applicants, Robert M. Szabo, describing concepts of the invention.

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The Disclosure was submitted by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM) on March 20, 2000. The Disclosure was insubstantially modified on April 13, 2001. No substantive modifications were made to the Disclosure after the initial submission. Indeed, as explained below, IBM's internal procedures governing the handling of such disclosures preclude any modification at all to the actual description of the invention once a disclosure has been submitted to an IBM IP professional.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as March 20, 2000. Specifically, each of the claimed features is clearly set out in the extensive description of the invention included in the Disclosure. (See, particularly, the written description at pages 1 and 2, as well as the detailed figure provided at the top of page 3.) The Disclosure further embellishes the concepts set out in the notebook entry dated February 8, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional. No modifications whatsoever can be made to the description of the invention itself after a disclosure form has been submitted.

The written description and each of the claims of the Application were prepared based upon the attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application

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prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective date Barenbaum to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants from at least March 20, 2000, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention. Applicants worked initially with IBM's own in-house IP professionals and subsequently with outside counsel retained by IBM to prepare and file the Application.

In a letter dated April 14, 2000, and submitted herewith, IBM instructed outside counsel to prepare and file an application for the invention described in the Disclosure. Outside counsel prepared the Application consistent with long-established professional practices. According to these established practices, outside counsel prepares cases on a first-in, first-out basis unless a particular case is associated with a bar date, in which event the case is granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

Applicants worked consistently with outside counsel during outside counsel's preparation of the Application. Evidence of specific activity undertaken by Applicants on specific dates is Applicants' response to the draft they received from outside counsel. Applicants received the draft enclosed with a letter dated January 5, 2001. The letter is submitted herewith. Applicants reviewed the draft and, in an e-mail dated January 29, 2001, responded with extensive comments. Applicants' e-mail is also submitted herewith. Outside counsel revised the draft consistent with Applicants' comments and filed the Application of February 16, 2001.

Applicants respectfully submit that their earlier conception coupled with due diligence from a date prior to the effective date of Barenbaum precludes using Barenbaum as a rejection for any of the claims. Accordingly, Applicants respectfully submit that each of the claims defines over the prior art.

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CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: November 6, 2006

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